

Application No. 10/692,132  
Amendment dated 03/22/2005

**Remarks/Arguments:**

**STATUS OF CLAIMS**

Claims 7 and 11 have been canceled without prejudice or disclaimer, and claims 1, 3, 12, and 13 have been amended, such that claims 1-6, 8-10, 12, and 13 are currently pending in the application.

**REMARKS**

In the Office Action dated January 12, 2005, the Examiner:

rejected claims 11-13 under 35 U.S.C. § 112, second paragraph, as being indefinite;  
rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,534,165 (hereinafter referred to as "Cumfer");  
rejected claims 1 and 8 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,290,248 ("Kemerer"); and  
rejected claims 2-13 under 35 U.S.C. §103(a) as being unpatentable over Cumfer or Kemerer.

**Applicant's Amendment of the Specification**

The specification has been amended to correct the size of the lower top and upper bottom exposures from approximately between 0.50% and 0.75% to approximately between 50% and 75%. This correction does not introduce new matter as the figures provide ample support for the correct sizes. More specifically, it can clearly be seen in the figures that these portions are at least 50%, or one-half, of the total length of the elongated body of the artificial shingle, not 0.50%, which is one-half of one percent.

The claims have been correspondingly amended as well.

**Response to Rejections under 35 U.S.C. §112, Second Paragraph**

Claims 12 and 13 have been amended to address the Examiner's concerns regarding indefiniteness.

**Response to Substantive Rejections**

The Examiner appears to have made a blanket rejection of all claims based solely on the issue of size and coverage of the relief pattern. Though the Examiner includes claims 6, 7, 9, 12, and 13 in this blanket obviousness rejection, nowhere in the Office Action is the subject matter of those claims specifically discussed. MPEP §2142 places

upon the Examiner the burden of establishing a *prima facie* case. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

The Applicant respectfully reminds the Examiner that he must satisfy three criteria in order to establish the requisite *prima facie* case: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596,1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 20 USPQ 2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Applicant respectfully asserts that the Examiner has not met his burden with respect at least to claims 6, 7, 9, 12, and 13. Dependent claim 6 introduces the limitation of at least one spacer (ref. num. 550 in FIG. 7) projecting from a side of the elongated body of the artificial shingle. The Examiner did not specifically address this claim, but the Applicant notes that neither Cumfer nor Kemerer disclose or suggest this feature.

Dependent claim 7 and independent claim 12 introduce the limitation of the bottom

surface of the elongated body having (a) a midline groove (ref. num. 142 in FIG. 3, and 542 in FIG. 7) of reduced thickness extending the length of the elongated body to facilitate bending the artificial shingle, and (b) a cuttable end tab (ref. num. 144 in FIG. 3, and 544 in FIG. 7) located at a bottom end of the midline groove, wherein the cuttable end tab can be cut as needed to facilitate folding the artificial shingle when the artificial shingle is mounted to the roof. These features are discussed in detail in the specification: broadly, the midline groove facilitates bending the artificial shingle to accommodate non-planar areas of the roof structure (e.g., ridgeline, hip, valley), and the cuttable tab can be cut as needed to facilitate such folding and otherwise conceals the midline groove from view. The Examiner did not specifically address claims 7 or 12, but the Applicant notes that neither Cumfer nor Kemerer disclose or suggest this feature.

More specifically, Cumfer discloses top and bottom kerfs, neither of which extends the length of the shingle. The upper kerfs are disclosed as allowing for a more durable and weather resistant strip of several joined shingles while retaining the appearance of conventional single shingles. More specifically, once the shingles are installed in a conventional overlapping fashion, the kerfs will be visible and give the appearance of single shingles even though, in fact, the shingles are joined in a strip. Even if the upper and lower kerfs cooperate to enhance flexibility of the strip, any such flexibility is between shingles in the strip rather than of any one of the individual shingles. So, for example, if Cumfer's strip were cut to provide individual shingles for use on a ridgeline, hip, or valley, the cut would be along the line defined by the upper and lower kerfs and would result in a single shingle having no such kerfs or other flexibility enhancing features. Lest the Examiner be tempted to assert that a single shingle could be created by cutting two adjacent shingles in half, thereby preserving the kerfs in the resulting single shingle, the Applicant notes that the result, when installed, would present the undesirable appearance of two shingles (defined by the exposed upper kerf) and, in any event, there is no motivation or suggestion for this solution - and certainly no suggestion of the desirability of this solution - in the cited references.

Kemerer discloses a wall panel - not a shingle - having an intermediate backside channel, but the stated purpose of the channel is to provide insulating dead-air space, not to enhance flexibility. In fact, midline flexibility would be undesirable in a wall panel; and therefore any proposed modification of Kemerer to result in such flexibility would render it unsatisfactory for its intended purpose, in which case, as mentioned, there can be no suggestion or motivation to make the proposed modification. MPEP §2143.01.

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The Examiner specifically addressed dependent claim 8, but not claim 9 which depends from claim 8, or independent claim 13 which includes the same limitation as claim 9. More specifically, claim 8 introduces the limitation of a lower portion (ref. num. 250 in FIG. 4) of the artificial shingle having a reduced thickness. Such a reduction in thickness provides a number of advantages including reducing the amount of material used in the final product, which lowers manufacturing costs; reduces cooling and set-up time; and reduces weight, all of which are discussed in the specification. Claims 9 and 13 introduce the further limitation of the portion of reduced thickness being provided with corrugations (ref. num. 252 in FIG. 4) to increase strength and stiffness of the area of reduced thickness. The Examiner did not specifically address claims 9 and 13, but the Applicant notes that neither Cumfer nor Kemerer disclose or suggest this feature.

Conclusion

In light of the foregoing, the Applicant respectfully asserts that claims 6, 7, 9, 12, and 13 are allowable over the cited prior art. Claims 12 and 13 are already in independent form. Claim 1 has been amended to include the limitation introduced by claim 7, and claim 7 has therefore been canceled.

The Applicant reserves the right to argue the allowability of claims 1-5, 8, 10, and 11 in a continuation application, and the Applicant's decision not to address the Examiner's rejections of those claims in the present response is not an admission of the correctness of those rejections but rather a desire to expedite the allowance of the particular claims which are addressed.

In the event of any questions, the Examiner is urged to contact the undersigned at (785) 766-0116.

Respectfully Submitted,  
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